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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/609,918	07/03/2000	Goran E. Enhoring	ENG901US	3605
7590	01/02/2003			
John C Thompson 69 Grayton Road Tonawanda, NY 14150			EXAMINER	
			CROSS, LATOYA I	
			ART UNIT	PAPER NUMBER
			1743	7
			DATE MAILED: 01/02/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/609,918	ENHORNING, GORAN E.
	Examiner LaToya I. Cross	Art Unit 1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 17 October 2002.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-5 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-5 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .

2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ . 6) Other: \_\_\_\_\_ .

## DETAILED ACTION

This Office Action is in response to Applicants' amendments filed October 17, 2002 and entered as Paper No. 6. Claims 1-5 are pending.

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1 remains to be rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,844,686 to Treptow et al.

Treptow et al '686 teach a pipette apparatus. The pipette apparatus comprises a piston (suction) portion and a pipette tip portion as recited in claim 1. The piston portion controls the draw of liquid up into pipette tip or the releasing of the liquid (col. 2, lines 47-55). The pipette tip serves to absorb the liquid. At col. 2, lines 33-36 and col. 3, lines 16-20, Treptow et al teach that the pipette tip is made of inexpensive plastic material. Regarding the relationship between the piston portion and pipette tip portion, Treptow et al teach that the piston is provided with an accommodation (3) for receiving the pipette tip (4) therein. The accommodation (3) serves as a female member into which the pipette tip is disposed (col. 4, lines 44-51).

Therefore, for the reasons set forth above, Applicants' claimed invention is deemed to be anticipated by Treptow et al '686.

***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 2 and 3 remains to be rejected under 35 U.S.C. 103(a) as being unpatentable over Treptow et al '686 in view of US Patent 5,468,453 to Holt et al.

The disclosure of Treptow et al '686 is given in detail above.

Treptow et al '686 fail to teach any particular plastic material for the pipette tip.

Holt et al '453 teach a pipette device having a pipette tip portion. The pipette tip is made of polytetrafluoroethylene plastic material (Teflon). See abstract and Col. 2, lines 43-54. The polytetrafluoroethylene is non-wettable (hydrophobic). It would have been obvious to one of ordinary skill in the art to use a teflon material, such as disclosed by Holt et al '453 to make the pipette tip of Treptow et al '686 because Holt et al '453 teach that Teflon inhibits fluid adhesion to the tube, thereby assuring a precise amount of liquid is taken up by the pipette.

Therefore, for the reasons set forth above, Applicants' claimed invention is deemed to be obvious in view of Treptow et al '686 and Holt et al '453.

5. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Treptow et al and Holt et al as applied to claims 2 and 3 above, and further in view of US Patent 4,362,063 to Marteau d'Autry.

The disclosure of Treptow et al '686 and Holt et al '453 is described above. Neither Treptow nor Holt teach a piston cylinder having a piston slidable within the piston cylinder. Treptow teaches a piston portion (1), but no slidable piston is disclosed within it.

Marteau d'Autry teaches a pipette for sampling and dispensing volumes of liquid sample. The pipette of Marteau d'Autry contains a capillary tube (24) having a slidably fitted piston (14) within it. A control rod (20) controls the movement of the piston within the tube. The capillary tube is equivalent to Applicants' piston cylinder. The piston is in the form of a stainless steel wire. The pipette having a tube capable of fitting a piston and a control means allows the pipette to be of shorter length and thus, provides easier handling by users and allows easier accommodation when used with automatic devices.

It would have been obvious to one of ordinary skill in the art to incorporate a slidable piston member within the piston of Treptow to decrease the overall length of the pipette and make the device easier to handle and better for use with automatic devices.

Therefore, for the reasons set forth above, Applicants' claimed invention is deemed to be obvious, within the meaning of 35 USC 103 in view of the teachings of Treptow, Holt and Marteau d'Autry.

***Response to Arguments***

6. Applicant's arguments filed October 17, 2002 have been fully considered but they are not persuasive. With respect to the rejection of claim 1 over Treptow and claims 2 and 3 over Treptow in view of Holt, Applicants argue that 1) the pipette of Treptow has an objective different from that of the instant invention, 2) the pipette of Treptow does not allow for securing a measured amount of sample and 3) the Treptow reference does not disclose that the pipette tip is made of extruded plastic tubing.

In response to Treptow have a different objective than that of Applicants, the position of

the Examiner is that Treptow teaches each of the elements instantly claimed. Thus, since the structure of the device is the same, the function or its objectives is immaterial. See MPEP 2114.

In response to Applicants' argument that Treptow does not allow for securing a measured amount of sample, Treptow teaches at col. 2, lines 39-43 that the pipette allows samples and possibly reagents to be exactly dosed into quantities. Applicants' claims do not require any specific quantities. Thus, the device of Treptow is sufficient to measuring specific quantities.

With respect to Applicants' argument concerning "extruded plastic tubing", Treptow teaches at col. 3, lines 17-19 and lines 50-52 that the pipette tip may be made of plastic materials. "Extruded" plastic refers to how the plastic is formed, which is given no patentable weight since it does not affect the structure of the device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is 703-305-7360. The examiner can normally be reached on Monday-Friday 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 703-308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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December 30, 2002

*Maureen M. Wallenhorst*  
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